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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/687,036

10/16/2003

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12/04/2009

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EXAMINER

TRAIL, ALLYSON NEEL

ART UNIT

PAPER NUMBER

2876

MAIL DATE

DELIVERY MODE

12/04/2009

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JANNE JALKANEN, HEIKKI HUOMO, and PETRI
VESIKIVI

Appeal 2009-004506
Application 10/687,036
Technology Center 2800

Decided: December 4, 2009

Before KENNETH W. HAIRSTON, JOSEPH F. RUGGIERO, and
ROBERT E. NAPPI, *Administrative Patent Judges*.

HAIRSTON, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. §§ 6(b) and 134(a) from the final rejection of claims 1, 2, 4, 11, 12, 14 to 16, 18, 25, 26, 29, 30, 32, 39, and 40.¹

We reverse.

STATEMENT OF THE CASE

The disclosed invention relates to a terminal, method, and computer program product for interacting with a signaling tag, and in particular, a radio frequency identification (RFID) transponder tag (Abstract; Spec. 1-2; claims 1, 15, 29). Appellants' disclosed and claimed method includes determining whether a terminal is actively operating an application, and then if it is, performing a predefined action based on the application and a state of the application (Abstract; claim 1).

Claim 1 is representative of the claimed invention, and reads as follows:

1. A method of interacting with a signaling tag comprising:

receiving information regarding a signaling tag at a terminal at least partially over an air interface;

determining whether the terminal is actively operating an application; and if the terminal is actively operating an application,

performing a predefined action based upon the application and a state of the application.

¹ Claims 3, 5 to 10, 13, 17, 19 to 24, 27, 28, 31, 33 to 38, and 41 have been objected to by the Examiner (*see* Final Rejection dated August 21, 2007, at 6) as being allowable if rewritten in independent form including all of the limitations of their base claims and any intervening claims.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Sepanaho	US 2002/0022961 A1	Feb. 21, 2002
Cremon	US 2002/0191998 A1	Dec. 19, 2002
Harumoto	US 2004/0203413 A1	Oct. 14, 2004 (filed Feb. 6, 2003)

The Examiner rejected claims 1, 2, 11, 12, 14 to 16, 29, and 30 under 35 U.S.C. § 102(b) based upon the teachings of Sepanaho.

The Examiner rejected claims 4, 18, and 32 under 35 U.S.C. § 103(a) based upon the teachings of Sepanaho and Cremon.

The Examiner rejected claims 25, 26, 39, and 40 under 35 U.S.C. § 103(a) based upon the teachings of Sepanaho and Harumoto.

Appellants argue, *inter alia*, (App. Br. 4-7; Reply Br. 2-5) that the applied reference to Sepanaho fails to teach or suggest a method of interacting with a signaling tag including the steps of “determining whether the terminal is actively operating an application,” and if so, “performing a predefined action based upon the application and a state of the application,” as set forth in claims 1, 15, and 29. More specifically, Appellants argue (App. Br. 4-5) that instead of determining whether a terminal is actively operating an application as in the claimed invention, “Sepanaho discloses executing a software program for receiving the URL, and for launching a browser,” and is “configured to perform a series of steps *irrespective* of a determination of whether the software program or browser is actively operating on the terminal” (App. Br. 4-5 (emphasis added)).

With regard to the anticipation rejection of claims 1, 2, 11, 12, 14 to 16, 29, and 30, the Examiner relies upon Sepanaho as disclosing the feature

recited in claims 1, 15, and 29 of determining whether a terminal is actively operating an application, and if so, performing a predefined action based upon the application and a state of the application. Specifically, the Examiner cites paragraph [0002] of Sepanaho as *clearly* disclosing the recited step of determining whether the terminal is actively operating an application (Ans. 4). The Examiner contends that (i) “[i]t must be determined that the user device includes this actively operating software application in order to ensure that the URL can be launched in the user device” (Ans. 7), and (ii) “a determination must first be made that the user device includes the necessary software application in order to ensure compatibility between the transmitter and the user device and to further ensure that the URL will be launched in the user device” (Ans. 8).

Sepanaho discloses, in paragraph [0002], a method and terminal for interacting with an RF signaling tag where a URL is transmitted to the user device or terminal, which, in turn, causes “an appropriate software program to be executed on the user device.” The launching of the software program “will in turn launch the appropriate software” such as a browser (§ [0002]). Although Sepanaho discloses transmitting a URL to a user device, and then launching appropriate software (§ [0002]), Sepanaho is silent as to determining whether the user device is actively operating an application, as set forth in the claims on appeal. Based on our finding with respect to Sepanaho, we agree with Appellants (App. Br. 4-5) that Sepanaho lacks the determining step of the claims, and instead operates to launch an application irrespective of determining whether the device is actively operating an application. This step is simply missing from Sepanaho, and the Examiner has not shown that such a step is inherent in the operation of Sepanaho.

Thus, with respect to the method, terminal, and computer program product for interacting with a signaling tag recited in claims 1, 15, and 29, Sepanaho fails to teach the steps of “determining whether the terminal is actively operating an application,” and, if so, “performing a predefined action based upon the application and a state of the application.” It follows that the Examiner has not established anticipation because Sepanaho does not disclose each and every limitation of the claimed invention set forth in independent claims 1, 15, and 29, or the invention set forth in claims 2, 11, 12, 14, 16, and 30, which depend respectively therefrom. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

The Examiner has not established a prima facie case of obviousness of the claimed subject matter set forth in dependent claims 4, 18, 25, 26, 32, 39, and 40 since the teachings of Cremon and Harumoto fail to cure the noted shortcomings of Sepanaho as set forth above. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

The anticipation rejection of claims 1, 2, 11, 12, 14 to 16, 29, and 30 is not sustained because Sepanaho does not teach determining whether the terminal is actively operating an application, and, if so, performing a predefined action based upon the application and a state of the application. The obviousness rejections of (i) claims 4, 18, and 32 over Sepanaho and Cremon, and (ii) claims 25, 26, 39, and 40 over Sepanaho and Harumoto are not sustained because the Examiner’s articulated reasoning concerning the teachings of Sepanaho, Cremon, and Harumoto do not support a legal conclusion of obviousness (*KSR Int’l. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007)).

CONCLUSION

The Examiner erred in rejecting claims 1, 2, 11, 12, 14 to 16, 29, and 30 under 35 U.S.C. §102(b).

The Examiner erred in rejecting claims 4, 18, 25, 26, 32, 39, and 40 under 35 U.S.C. §103(a).

DECISION

The Examiner's decision rejecting claims 1, 2, 4, 11, 12, 14 to 16, 18, 25, 26, 29, 30, 32, 39, and 40 is reversed.

REVERSED

gvw

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